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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Benjamin MANDLER
Application No.: 09/929,260 Conf. No. 9743
Filed: August 15, 2001
For: USE OF SPECIAL DIRECTORIES FOR ENCODING SEMANTIC INFORMATION ...

Art Unit: 2165
Examiner: S.G. Rimell
Washington, D.C.
Atty.'s Docket: MANDLER=1
Date: November 9, 2006

THE COMMISSIONER OF PATENTS
U.S. Patent and Trademark Office
Randolph Building, Mail Stop AF
401 Dulany Street
Alexandria, VA 22314

Sir:

Transmitted herewith is a [] Amendment [X] REPLY BRIEF

in the above-identified application.

- [] Small Entity Status: Applicant(s) claim small entity status. See 37 C.F.R. §1.27.
[XX] No additional fee is required.
[] The fee has been calculated as shown below:

	(Col. 1)		(Col. 2)	(Col. 3)
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA EQUALS
TOTAL	* 78	MINUS	** 90	0
INDEP.	* 9	MINUS	*** 9	0
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM				

SMALL ENTITY	
RATE	ADDITIONAL FEE
x 25	\$
x 100	\$
+ 180	\$
ADDITIONAL FEE TOTAL	
\$	

OTHER THAN SMALL ENTITY	
RATE	ADDITIONAL FEE
x 50	\$
x 200	\$
+ 360	\$
TOTAL	
\$	

- * If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.
** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.
*** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

- [XX] Conditional Petition for Extension of Time
If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

- [] It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

Small Entity
Response Filed Within
[] First - \$ 60.00
[] Second - \$ 225.00
[] Third - \$ 510.00
[] Fourth - \$ 795.00
Month After Time Period Set

Other Than Small Entity
Response Filed Within
[] First - \$ 120.00
[] Second - \$ 450.00
[] Third - \$ 1020.00
[] Fourth - \$ 1590.00
Month After Time Period Set

- [] Less fees (\$) already paid for month(s) extension of time on .

- [] Please charge my Deposit Account No. 02-4035 in the amount of \$.
[] Credit Card Payment Form, PTO-2038, is attached, authorizing payment in the amount of \$.
[] A check in the amount of \$ is attached (check no.).

- [XX] The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of)	Attorney Docket: MANDLER=1
Benjamin Mandler et al.)	Group Art Unit: 2165
Serial No.: 09/929,260)	Confirmation No.: 9743
Filed: August 15, 2001)	Examiner: Samuel G. Rimell
For: USE OF SPECIAL DIRECTORIES)	Washington, D.C.
FOR ENCODING SEMANTIC)	
INFORMATION IN A FILE SYSTEM)	November 9, 2006

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Randolph Building, Mail Stop AF
401 Dulany Street
Alexandria, VA 22314

REPLY BRIEF

Sir:

In response to the Examiner's Answer, dated September 11, 2006, Appellant respectfully submits the following remarks.

1) Background

Claims 67, 68, 76-80 and 88-90 in this application were rejected under 35 U.S.C. 102(e) over subject matter appearing in Fig. 8 and in claims 19, 20, 22 and 23 of US 2001/0049675. The inventors in the present case are Benjamin Mandler and Roman Talyansky. The inventors in US 2001/0049675 are Mandler, Maarek-Smadja, Azagoury, and Factor.

Appellant submitted declarations under 37 C.F.R. 1.132 by the inventors in both the present application and in US 2001/00049675 stating unequivocally that (1) Mandler was the sole inventor of the rejected claims in the present application, and (2) Mandler was the sole inventor of the subject matter disclosed in Fig. 8 and in claims 19, 20, 22 and 23 of US 2001/0049675. Since the same inventor was the source of both the claimed subject matter in the present application and the cited subject matter in the prior art, the rejection under 35 U.S.C. 102(e) should have been withdrawn. The Examiner maintained the rejection,

however, on the grounds that the declarations submitted by Appellant were not sufficient to prove that Mandler was the sole inventor of the subject matter in question.

2) The issues at hand

In the Appeal Brief, Appellant reviewed the relevant case law and established the following conclusions:

- (A) *In the absence of evidence to the contrary, unequivocal statements by the inventors in the present application are in and of themselves sufficient to resolve questions of inventorship, including inventorship of subject matter cited in the prior art (see MPEP 716.10, In re Katz).*
- (B) *The mere fact that a patent application lists multiple inventors is not “evidence to the contrary.”* In the case law, the courts have found the applicant’s statements to be insufficient only in the face of contradictory statements by other parties (*In re Kroger*, cited in MPEP 716.10) or at least equivocation in statements submitted by other parties (*In re Carreira*).
- (C) Even if there were a basis in the present case for doubting the unequivocal statements by the inventors (Mandler and Talyansky), *that doubt should have been put to rest by the additional unequivocal statements by all of the authors of the cited art.*

In the Examiner’s Answer to the Appeal Brief, the Examiner evidently accepted point (A), but refused to accept point (B). The Examiner failed to relate to point (C). Instead, the Examiner persisted in maintaining that the declarations by the inventors in the present application and in US 2001/0049675 are not “objective evidence” and are therefore insufficient to remove the cited subject matter US 2001/0049675 as prior art in the present case.

In the sections that follow, Appellant will analyze and refute the points that the Examiner has raised.

3) The Examiner's demand for "objective evidence" is arbitrary and without foundation in MPEP or the case law.

The Examiner stated (page 7 in the Examiner's Answer) that Appellant had made the "fundamental assertion" that "the procedures set forth in the MPEP make no requirement for appellant to submit objective evidence in addition to unequivocal statements by the inventors." The Examiner has incorrectly represented both the content of MPEP and Appellant's argument in this regard. The term "objective evidence" does not appear at all in MPEP in the context of proof of inventorship, and it is not clear what sort of evidence would meet the Examiner's arbitrary standard of "objectivity." The point Appellant has made repeatedly in this case is that the unequivocal statements by all of the inventors in the present application and in US 2001/0049675 are themselves objective evidence sufficient to meet the requirements of MPEP. In proving inventorship under 37 CFR 1.132, MPEP and the relevant case law make no requirement that any further documentary evidence or explanation be submitted beyond these declarations.

4) The case law and MPEP clearly require no more than unequivocal statements by the applicant to resolve the questions of inventorship in the present case.

In the context of his arguments regarding "Declaration A," the Examiner selectively cited *In re Katz* with regard to ambiguity of inventorship: "inquiry is appropriate to clarify any ambiguity created by an article regarding inventorship and it is then incumbent upon the application to provide a satisfactory showing..." (emphasis added by Examiner). The Examiner failed to quote the remainder of this very citation, as it appears in MPEP 716.10: What MPEP calls for is "'a satisfactory showing that would lead to a reasonable conclusion that [applicant] is the... inventor' of the subject matter disclosed in the article and claimed in the application." MPEP 716.10 itself makes clear in the same paragraph what sort of showing is required: "a satisfactory showing by way of affidavit under 37 CFR 1.132..." (emphasis added).

It is no wonder that the Examiner omitted the latter part of the quote from MPEP. In juxtaposition with the dictates of MPEP and the case law, the Examiner must be insisting that unequivocal statements by all of the inventors in this case and in US 2001/0049675 would not

lead to a “reasonable conclusion” that these very unequivocal statements are true. He is stating, in effect, that all of the declarants are assumed to be lying unless they can prove otherwise. This position is at odds with the rules of evidence generally, as well as with the specific rules relating to the proof of inventorship.

Furthermore, the Examiner, while quoting *In re Katz*, has ignored the fact that in *Katz*, the court found that Katz’s own unequivocal declaration was sufficient to prove his inventorship (see the detailed analysis in the Appeal Brief). Although the case law regarding 37 CFR 1.131 may require documentation (in addition to statements by the inventors) of date of invention, there is no such requirement with respect to establishing the identity of inventors under 37 CFR 1.132.

5) **Appellant’s “Declarations B and C” are more than sufficient to prove that Mandler was the sole inventor of the subject matter in question.**

The Examiner related at length in his arguments to the purported inadequacy of “Declaration A,” by Benjamin Mandler, submitted May 23, 2005 (pages 5-6 in the Examiner’s Answer). Since Appellant subsequently submitted “Declarations B and C,” in which Mandler’s statements were unequivocally supported by his co-inventors in the present application and in US 2001/0049675, the adequacy of Declaration A is not even at issue. The Board should direct its attention to Declarations B and C, which were made by all of the inventors in the present application and in US 2001/0049675. These declarations, on their face, leave not the slightest doubt that every one of the people involved, who were in a position to know who invented what, recognize Mandler as the sole inventor of the subject matter in question.

6) **The declarations submitted in this case present a reasonable, consistent account of the facts.**

The Examiner held that the declarations submitted by Appellant “produce an ambiguous picture of inventorship” (page 7 in the Examiner’s Answer). Specifically, the Examiner stated that “no accounting is made for the contributions [of the] co-inventor in the present application, Roman Talyansky” in Declaration B, and that with regard to Declaration

C, "Since Roman Talyansky claimed inventorship on dependent claims that incorporate the subject matter of independent claims, his contribution to the independent claims cannot be fully ruled out."

It appears, therefore, that the Examiner would like to impute to Talyansky a role in the invention of the subject matter of independent claims 67 and 79. The Examiner himself, however, has maintained that this very subject matter was disclosed in US 2001/0049675, where Talyansky was not even one of the inventors. There is no evidence on the record to suggest that Talyansky should have been listed as an inventor in US 2001/0049675, and the fact that he was not listed creates the presumption that he was not an inventor in that case. Therefore, Talyansky could not possibly have been an inventor of the independent claims in the present application, unless the Examiner were to disavow his rejection of these claims as having been anticipated by US 2001/0049675. The Examiner's position, in other words, is self-contradictory, and could be true only if the Examiner were also alleging that all the declarants in the present case were partners in fraud by omitting Talyansky from the list of inventors in US 2001/0049675. The Examiner, thankfully, has made no such allegation.

Rather, the fact picture that clearly arises from the declarations submitted in this case is that Mandler originally invented the subject matter of claims 67, 68, 76-80 and 88-90, and was joined subsequently by Talyansky in inventing the additional subject matter of claims 69 and 81. Everything in the factual record and in the declarations submitted by Appellant is consistent with this picture. Contrary to the Examiner's assertion, Talyansky's contribution to the independent claims has been fully ruled out both by the declarations and by the fact pattern of this case.

7) Summary

To summarize, the unequivocal declarations submitted in this case are more than sufficient to meet Appellant's burden of proof that Mandler was the sole inventor of the subject matter cited by the Examiner in US 2001/0049675 and of claims 67, 68, 76-80 and 88-90 in the present patent application. The Examiner's reasons for questioning the declarations submitted by Appellant are based on selective citation and incorrect interpretation of MPEP, and on an interpretation of the facts of the case that is self-


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contradictory. The Examiner's demand for additional evidence in support of the declarations is without foundation in MPEP, in the relevant case law, or in the specific facts of this case.

Therefore, US 2001/0049675 should be disqualified as prior art under 35 U.S.C. 102(e) against the claims in the present patent application, and all of the claims should be allowed.

Respectfully submitted,

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